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09/593,759	06/14/2000	Peter Given	2105.2130	9001

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18  
EXAMINER

PRATT, HELEN F

ART UNIT

PAPER NUMBER

1761

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/593,759

**Applicant(s)**

GIVEN ET AL.

**Examiner**

Helen F. Pratt

**Art Unit**

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-11, 13-20, 25 and 29-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-11, 13-20, 25, 29-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                              | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____.                                   |

## DETAILED ACTION

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 10-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Application No. 09/982,180. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of '180 contain the ingredients of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4-11, 13-20, 25, 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Braun et al. in view of Couzy and Lindon et al. and further in view of Yang et al. (2002/0146486) and Brafford et al. (6,326,038).

The claims are rejected for the reasons of record cited in the last office action.

**ARGUMENTS**

Applicant's arguments filed 6-30-03 have been fully considered but they are not persuasive.

Applicants argue that there is no motivation to combine the reference teachings in that each of the references teach as recited and there is no explicit or implicit suggestion to combine the references and that the claimed beverage would not have been produced from that combination of references. However, the references were used to show that various limitations of the claims are known in conjunction with In re Levin, which teaches that nothing unobvious is seen in adding or removing ingredients from the composition. Applicants have reduced their compositions down to very few elements, and nothing new is seen in picking and choosing ingredients absent anything new or unobvious. For example applicants state that references containing acids could not be used, yet they use ascorbic acid in their compositions (page 12, lines 16-24) and

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tables 2 and 3. As for the beverages, nothing new is seen in adding and taking out various ingredients as in *In re Levin*.

Applicants state that their composition is bland neutral tasting. However, various references state that calcium sulfate tends to be sour or bitter. For instance, Brafford et al. state that calcium sulfate tends to cause bitterness. No upper level is seen in the claims to keep the composition from becoming bitter, yet the composition is said to be bland, and neutral tasting.

Applicants argue that one of ordinary skill in the art would expect to achieve unacceptable results when fortifying alone with calcium sulfate at 10% RDV. Applicant's specification states that this bland taste is at 10% of the RDV, not at more than that (page 6, lines 10-20). At more than these levels one would expect to have bitterness as taught by the references. Therefore, one must assume that the use of flavorants will reduce any bitterness, however, no amounts are seen to effect this. Since no particular amounts are deemed necessary, except more than 10% calcium sulfate, it must be assumed that it would have been within the skill of the ordinary worker to use particular amounts of ingredients to make an acceptable product. The references in combination show that all the ingredients are known, and it is seen that applicants are using ordinary skill of the worker to make the claimed composition, and removing ingredients from beverages, which does not show invention as in *In re Levin*. Nothing new is seen in the use of "at least about 10% calcium sulfate", since one is taught by Brafford and Yang that the use of higher amounts results in bitterness. The

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references to Brafford and Yang also illustrate these principles as cited in applicants' discussion on page 5.

The references are not used for expectations of success but for what they teach as cited in the office actions. As the various limitations have been disclosed one would expect success.

Applicants argue that there is no cited source of a hydrate form of calcium sulfate. Yet on page 7 of the specification, this is not seen as a critical feature as anhydrous forms are disclosed.

Therefore, it is seen that the references in combination do show that it would have been obvious to make the claimed composition.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Helen F. Pratt at telephone number 703-308-1978.

8-12-03

  
**HELEN PRATT**  
**PRIMARY EXAMINER**